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MS APPEAL BRIEF - PATENTS
PATENT
2565-0225P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Before the Board of Appeals

WADAKA, et al.

Appeal No.:

Appl. No.: 09/778,872

Group: 2834

Filed: February 8, 2001

Examiner: M. Budd

Conf.: 9099

For: FILM ACOUSTIC WAVE DEVICE AND ITS
MANUFACTURING METHOD AND CIRCUIT DEVICE

REPLY BRIEF TRANSMITTAL FORM

MS APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

October 11, 2005

Sir:

Transmitted herewith is a Supplemental Reply Brief on behalf of the appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

The Supplemental Examiner's Answer was mailed on August 10, 2005.

☐ An extension of time under 37 C.F.R. § 1.136(b) to _____ was requested on _____ and was approved on _____.

☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

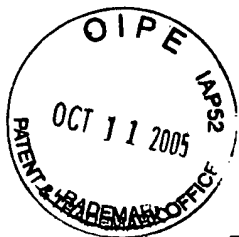
By


Michael K. Mutter, #29,680

MKM/rw
2565-0225P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment(s)



MS APPEAL BRIEF - PATENTS
PATENT
2565-0225P

IN THE U.S. PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

WADAKA, Shusou et al.

Appeal No.:

Appl. No.: 09/778,872

Group: 2834

Filed: February 8, 2001

Examiner: M. Budd

Conf.: 9099

For: FILM ACOUSTIC WAVE DEVICE AND ITS
MANUFACTURING METHOD AND CIRCUIT
DEVICE

SUPPLEMENTAL REPLY BRIEF

MS APPEAL BRIEF – PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

October 11, 2005

Sir:

Submitted herewith is a reply to the supplemental examiner's answer filed within the time period set forth under 37 CFR § 1.93(b)(1).

Argument

The Board, in their order dated December 6, 2004, noted that the Examiner's Answer did not present specific arguments in support of the rejection of claims 35-39, 61, and 62 under 35 U.S.C. § 103. At the same time, the Board noted that appellants addressed all of the rejections on appeal including this rejection.

Claims 61 and 62

While claims 35-39 recite specific materials, claims 61 and 62 require varying the thickness of the piezoelectric thin film based on location on the wafer. Claim 61 requires the thickness of the piezoelectric thin film to be varied "based on the location of at least one acoustic wave device on the wafer" as recited in parent independent claim 24. Similarly, dependent claim 62 recites how the piezoelectric thin film varies based on location on the wafer. The examiner has not pointed to any basis whatsoever to support the rejection of these dependent claims. In the absence of a specific allegation or evidence with respect to claims 61 and 62, it is respectfully submitted that the rejection of the examiner has not presented a *prima facie* case of obviousness as to these references and the rejection should be reversed.

Claims 35-39

With respect to claims 35-39, the examiner specifically alleges that all of the materials specified are known¹. The examiner appears to contend that it would be obvious to one of ordinary skill in the art to replace the materials of any of the four references relied on, with the specific materials recited in these claims. It is respectfully submitted that the examiner has not made a *prima facie* case of obviousness with respect to these claims. The replacement of one material for the other must be based on some motivation for the modification proposed by the examiner's rejection. The examiner has identified no basis for such a motivation, and in the absence of such a rejection, the examiner's rejection amounts to no more than a hindsight reconstruction attempt. The teaching or suggestion to make the claimed combination and the

¹ The materials recited in the claims may be known generally but there is not *prima facie* case to support their substitution for those recited in the references.

reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 747F. 2d 488, 20, U.S.P.Q.2d 1438 (Fed. Cir. 1991)

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. However, absent a motivation to combine, there can be no *prima facie* case of obviousness. The examiner has pointed to no evidence supporting the substitutability of one material for another or any other motivation to support his case of obviousness. Since the examiner has not provided such a suggestion or motivation to modify any of the references to include the recited materials, the examiner has not met his burden to establish a *prima facie* case with respect to these dependent claims.

For all of the reasons previously submitted and the reasons submitted in the attached reply brief, the examiner is respectfully requested to reconsider and withdraw the outstanding rejection and pass all claims to issue in the present application.

Respectfully submitted,

BIRCH STEWART KOLASCH & BIRCH, LLP

By: _____

Michael K. Mutter
Registration No. 29,680

MKM/rw
2565-0225P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000